

Independent claim 15 recites a tape roll that includes a central tape roll axis and a length of tape circumferentially wound about the axis, the tape having first and second sides. The second side (which faces inward, toward the axis) is at least partially covered with pressure sensitive adhesive. The tape roll also includes a tab having first and second sides. At least a portion of the second side of the tab is covered with pressure sensitive adhesive. The adhesive portion of the second side of the tab is adhered to the first side of the tape on a penultimate layer of the roll, so that the trailing end of the tape overlays the tab between first and second ends of the tab.

Japanese 7-78203 discloses a tape roll that includes a length of tape (6) circumferentially wound about an axis, the tape having first and second sides, where the second side is at least partially covered with pressure sensitive adhesive (the adhesive is designated as (5) in FIGS. 3 and 4)). A leading paper is glued to the tape (6) by the adhesive (5) on the second side of the tape (the side that is at least partially covered with pressure sensitive adhesive). The leading paper is manipulated so that only portion B contacts the adhesive (5), and portion (A) is bent up to avoid contacting the adhesive (5). See FIG. 3 and page 4, third paragraph. After the leading paper is glued, the tape (6) is cut by the tape cutter (9) at a point that is a short distance from the end of the length (1) of the leading paper.

Japanese 7-78203 does not disclose the use of pressure sensitive adhesive anywhere on the tab (leading paper). Instead, the leading paper of Japanese 7-78203 is adhered to the end region of the tape (6) with the pressure sensitive adhesive (5) that is on the second side of the tape. No adherence to the first side of the tape (6) is disclosed. Claim 15 recites "the second side of the tape is at least partially covered with pressure sensitive adhesive," "at least a portion of the second side of the tab is covered with pressure sensitive adhesive," and "the adhesive portion of the second side of the tab is adhered to the first side of the tape on a penultimate layer of the roll." These elements are not disclosed, taught or suggested by Japanese 7-78203, and the rejection of claim 15 under 35 U.S.C. § 102(b) should accordingly be withdrawn.

The Examiner appears to suggest that the second side of the tab (leading paper) of 7-78203 satisfies the recited element of claim 15 ("at least a portion of the second side of the tab is covered with pressure sensitive adhesive") because the leading paper is adhered to the tape surface. Regardless of the technical merits of this suggestion, even this interpretation of 7-78203 fails to satisfy all of the recited elements of claim 15, because the leading paper of 7-78203 is disclosed and shown as being adhered to the second side of the tape (the side that is coated with adhesive (5)), while claim 15 recites that "the adhesive portion of the second side of the tab is adhered to the first side of the tape on a penultimate layer of the roll" (emphasis added).

Claims 16, 17, 21 and 27-30 depend from independent claim 15, and for at least the reasons discussed above, are allowable therewith.

Claim Rejections – 35 U.S.C. § 103

Claims 15-17 and 20-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese 7-78203 in view of Golub (USP 2,329,537).

The Examiner cited Golub for the proposition that "it would have been obvious to one having ordinary skill in the art to utilize Golub's teaching the trailing end of a tape which overlays a tab having adhesive and non-adhesive portions in the invention of The English Translation of the Japanese: 7-78203 with the motivation to provide for facilitating separability and unwinding of the tape roll." This proposition was deemed necessary because the Examiner noted that "The English Translation (of 7-78203) ... fails to teach that the trailing end of the tape overlays both the adhesive and the non-adhesive portions of the tab."

In order to reject a claim under 35 U.S.C. § 103 as being obvious, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. 2143.

Combining the teachings of Golub with the teaching of 7-78203 would result in the trailing end of the tape (6) of 7-78203 extending beyond the end of the trailing paper, as taught by Golub (see FIG. 6 and page 2, left column, lines 3-14). One skilled in the art would not be motivated to make this modification to 7-78203, in view of the fact that a portion (A) of the leading paper of 7-78203 is specifically configured to extend from the tape to allow grasping of the tape to release the tape from the roll (see FIG. 2 and page 3, second paragraph). Moreover, if such a modification is made to 7-78203, then the trailing end of the tape would not overlay the tab between the first and second ends of the tab, as is required by independent claim 15. Therefore, since there is no suggestion or motivation to combine the references cited by the Examiner, and since the combination of references would not teach or suggest all of the limitations of claim 15, the rejection of claim 15 under 35 U.S.C. § 103(a) should be withdrawn.

Claims 16, 17 and 20-30 depend from independent claim 15, and for at least the reasons discussed above, are allowable therewith.

Claim Objections – Allowable Subject Matter

Claims 18 and 19 were objected to as depending from a rejection base claim, but were indicated to be allowable if rewritten in appropriate form. The Examiner's indication of allowable subject matter is gratefully acknowledged. For the reasons discussed above, independent claim 15 is in condition for allowance, and the objections to claims 18 and 19 should accordingly be withdrawn.